

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Anderson et al.

Confirmation No.:

Application No.: 09/965,386

Examiner: D. Lee

Filing Date: Sep. 27, 2001

Group Art Unit: 2876

Title: Systems and Methods for Automatic Language Selection for System User Interface

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith in **triplicate** is the Appeal Brief in this application with respect to the Notice of Appeal filed on March 31, 2004.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$330.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

() (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

() one month	\$110.00
() two months	\$420.00
() three months	\$950.00
() four months	\$1480.00

() The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

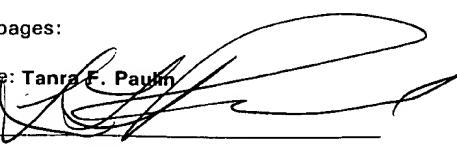
Please charge to Deposit Account **08-2025** the sum of \$330.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

Anderson et al.

By


Steven R. Ormiston

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Date: **May 28, 2004**

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**IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

INVENTOR(S): Anderson et al.

ATT. DOCKET NO. 10017511-1

SERIAL NO.: 09/965,386

GROUP ART UNIT: 2876

FILED: September 27, 2001

EXAMINER: D. Lee

TITLE: Systems and Methods for Automatic Language Selection
for System User Interface

APPELLANTS/APPLICANTS' OPENING BRIEF ON APPEAL

1. REAL PARTY IN INTEREST.

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holding, LLC.

2. RELATED APPEALS AND INTERFERENCES.

There are no other appeals or interferences known to Appellants, Appellants' legal representative or the Assignee which will affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

3. STATUS OF CLAIMS.

Claims 1-4, 6-9, 11-15, 17-23 and 25 are pending. All pending claims are

appealed.

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4. STATUS OF AMENDMENTS.

No amendments were filed after the final action.

5. SUMMARY OF INVENTION.

Embodiments of the invention facilitate automatically selecting a language desired by a user of a machine that utilizes an interactive interface, such as an automated teller machine, by pre-programming a smart card or other portable memory medium with primary and secondary preferred language identifiers. Specification, page 2, line 5 through page 3, line 2. For example, the method of Claim 1 includes reading primary and secondary language identifiers (e.g., identifiers 302 and 304 in Fig. 3) from a portable memory medium (e.g., card 102 in Fig. 1) and displaying a user interface in a secondary preferred language associated with the secondary language identifier if a primary preferred language associated with the primary language identifier is unavailable.

6. ISSUES.

1. Has the Examiner made the specific factual findings based on objective evidence required to support modifying the combination of Matsukawa (5,436,436) and Abe (5,895,903)?

2. Would it have been obvious to combine Matsukawa and Abe and then to modify the combination as asserted by the Examiner?

7. GROUPING OF CLAIMS.

Applicant proposes the following grouping of claims according to the Issues noted above in Section 6.

Issues No. 1-2: All claims stand or fall together under each of Issues No. 1-2.

8. ARGUMENT.

Claims 1-4, 6-9, 11-15, 17-23 and 25 stand rejected under 35 U.S.C. § 103 as being obvious over Matsukawa (5,436,436) in view of Abe (5,895,903) (Claims 1-3, 6-7, 9, 12 15, 19-20 and 22-23) or Matsukawa "as modified by Abe and further in view of Akiyama (4,736,405)" (Claims 2, 4, 8, 11, 13-14, 17-18, 21 and 25).

ISSUE NO. 1

The Examiner Has Not Made The Specific Factual Findings Based On Objective Evidence Required To Support Modifying The Combination Of Matsukawa And Abe

The Examiner supports the rejections with an unusual two-layered obviousness analysis. First, she asserts the combination of Matsukawa (5,436,436) and Abe (5,895,903) is obvious. Then, second, she asserts that it is obvious to modify the combination to meet all of the claim limitations. Obviousness can only be established by modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The Examiner must rely on *objective evidence* and make *specific factual findings* with respect to the motivation to modify references. MPEP § 2143.01; See, e.g., *In re Sang Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). As detailed below, the Examiner has failed to make the required findings.

Claims 1, 7, 12, 17, 20 and 25 cover, in various forms, the use of a portable memory that includes two language identifiers such that, if the language associated with the first identifier is not available, the language associated with the second identifier is used. For example, the method of Claim 1 includes reading primary and secondary language identifiers from a portable memory medium and displaying a user interface in a secondary preferred language associated with the secondary language identifier if a primary preferred language associated with the primary language identifier is unavailable. Claim 17, as another example, is directed to an ATM card comprising memory means for storing a primary language identifier that identifies a primary preferred language of the card owner and a secondary language identifier that identifies a secondary preferred language of the card owner.

The Examiner acknowledges that the combination of Matsukawa and Abe does not teach a portable memory with two language identifiers or the use of those identifiers, as claimed. To stretch the prior art to reach the claimed invention, the Examiner makes the following statement.

"Matsukawa as modified by Abe does not teach the language of the language identifier explicitly having a primary and a secondary identifiers,[sic] it would have been an obvious [sic] to an artisan of ordinary skill in the art at the time the invention was made to simplify the

user's appropriate language selection in the identification data to explicitly identifying [sic] the first and the second preferred language (i.e., user's most comfortable language as the first preferred language and a default language as the second preferred language) so that the terminal can most identifies [sic] and accommodates the user's comfortable language with less operating time when the user's first preferred language is not identified or not a popularly utilized language by the terminal. Such modification would reduce the operating time in determining the specific selection when system finds multiple languages that terminal can support from the user's selection." Office Action mailed December 2, 2003, page 4.

There is nothing in the remarks quoted above (or anything else in the December 2 Office Action) that constitutes specific factual findings that Matsukawa or Abe suggests or motivates two language identifiers or the use of those identifiers, as claimed. There is nothing in the remarks quoted above (or anything else in the December 2 Office Action) that constitutes specific factual findings relying on objective evidence of something in the knowledge generally available to those skilled in the art that suggests or motivates the modification to arrive at the two language identifiers or the use of those language identifiers, as claimed. Rather than making specific factual findings based on objective evidence, the Examiner speculates on possible advantages of the claimed invention as the motivation to modify the combination of Matsukawa and Abe. The Examiner asserts that using two language identifiers would "simplify the user's appropriate language selection" and "reduce the operating time in determining the specific selection when system finds [sic] multiple languages that terminal can support...." This is pure speculation. The Examiner has no way of knowing if this is true. More importantly, she has not cited to anything in the prior art or to any other objective evidence that supports her assertion. As the Federal Circuit has well noted, "[t]his factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority." *In re Sang Su Lee*, 277 F.3d at 1343-44.

Appellants acknowledge that MPEP § 2144 characterizes "some advantage or expected beneficial result" of a combination or modification of references as "the strongest rationale" for combining or modifying the references. Even assuming this somewhat extreme characterization is valid, it does not give the Examiner carte blanche to speculate on possible advantages. Any such advantage or beneficial result must be "[recognized], expressly or impliedly in the prior art or drawn from a convincing

line of reasoning based on established scientific principles or legal precedent...." MPEP § 2144, citing *In re Sernaker*, 702 F.2d 989, 994-95 (Fed. Cir. 1983). The Examiner has not shown that the advantage on which she relies is recognized in the prior art or that it is drawn from a convincing line of reasoning based on established scientific principles or legal precedent.

The Examiner is required to provide ***objective evidence*** and make ***specific factual findings*** with respect to the motivation to modify the combination of references. Absent such a showing, the rejections should be withdrawn.

ISSUE NO. 2

It Would Not Have Been Obvious To Combine Matsukawa And Abe And Then To Modify The Combination As Asserted By The Examiner

Matsukawa teaches a telephone card containing a single language identifier that, when read by a telephone, causes the telephone to display messages in the language identified on the card. Matsukawa assumes the language identified on the card is available on the telephone. That is to say, Matsukawa does not contemplate a circumstance in which the language identified on the card is not available on the telephone.

Abe teaches a financial card containing a single language identifier that, when read by an electronic terminal, causes the terminal to display or play messages in the language identified on the card. If the identified language is not available on the terminal, then a default language is used or the user is allowed to select a desired language. Abe, column 7, lines 46-52.

There is nothing in either of these references that suggests the use of a secondary preferred language identifier, as claimed. Matsukawa seems to have anticipated a system distributed by a single entity (telephone manufacturer) that controlled distribution of the portable memory devices (phone cards) that contained the language identifier. In such a case, a system manufacturer would know which languages to include in the system, since the manufacturer would know which languages would be used with the portable memory devices. Therefore, one skilled in the art would have no reason to include a secondary language identifier. In the present application, systems (such as ATMs) manufactured by a first entity may be used with portable memory devices (such as ATM cards) issued by numerous other entities. In

this case, the system manufacturer cannot anticipate all the languages that would need to be stored in a particular system. As such, it is more likely that a secondary language identifier would be required. Provision of a secondary preferred language identifier would significantly enhance the disclosure of Abe, yet Abe does not even hint at this feature.

Appellants respectfully submit that the use of a secondary preferred language identifier only becomes obvious when one reads the present application. And, of course, it is improper in determining whether a person of ordinary skill would have been led to this combination of references simply to "[use] that which the inventor taught against its teacher." W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1983).

Respectfully submitted,
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By



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APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

1. A method for automatically selecting a language in which to display a user interface, comprising:

reading a primary language identifier from a portable memory medium;

reading a secondary language identifier from the portable memory medium;

identifying a primary preferred language associated with the primary language identifier, the primary preferred language being a language preferred by a portable memory medium user;

in the event that the primary preferred language is unavailable, identifying a secondary preferred language associated with the secondary language identifier, the secondary preferred language being a language preferred by the user if the primary preferred language is unavailable; and

displaying the user interface in the secondary preferred language.

2. The method as recited in claim 1, wherein the portable memory medium further comprises a card having a magnetic strip.

3. The method as recited in claim 1, wherein the portable memory medium further comprises an integrated circuit card.

4. The method as recited in claim 1, wherein the portable memory medium further comprises an automated teller machine (ATM) card.

6. A computing device comprising memory that stores computer-executable instructions that, when executed by a processor of the computing device, performs the method recited in claim 1.

7. A portable memory medium configured to be inserted into an interface of a computing device for effecting identification of an owner of the medium, said computing device including a display that displays a computing device user interface, the portable memory medium comprising memory means for storing personal data and a language identifier that identifies a primary preferred language of the owner and a

secondary preferred language of the owner, wherein said display presents the user interface in the secondary preferred language after reading the language identifiers from the portable memory medium and determining that the primary preferred language is unavailable.

8. The portable memory medium as recited in claim 7, wherein the memory means further comprises a magnetic strip.

9. The portable memory medium as recited in claim 7, wherein the memory means further comprises an integrated circuit.

11. The portable memory medium as recited in claim 7, wherein the computing device further comprises an automated teller machine (ATM) and the portable memory medium further comprises an ATM card.

12. A method for configuring a portable memory medium for use by an owner of the portable memory medium, comprising:

storing personal data associated with the owner in memory means of the portable memory medium;

storing a primary language identifier in the memory means of the portable memory medium, the primary language identifier indicating a primary preferred language of the owner;

storing a secondary language identifier in the memory means of the portable memory medium, the second language identifier indicating a secondary preferred language of the owner; and

wherein a computing device designed to operate with the portable memory medium displays a user interface in the secondary preferred language of the owner of the portable memory medium after the computing device reads the language identifiers from the portable memory medium and determines that the primary preferred language is unavailable.

13. The method as recited in claim 12, wherein the computing device further comprises an automated teller machine (ATM) and the portable memory medium further comprises an ATM card.

14. The method as recited in claim 12, wherein the memory means further comprises a magnetic strip.

15. The method as recited in claim 12, wherein the memory means further comprises an integrated circuit.

17. An automated teller machine (ATM) card, comprising memory means for storing:

personal data related to an ATM card owner;

a primary language identifier that identifies a primary preferred language of the ATM card owner;

a secondary language identifier that identifies a secondary preferred language of the ATM card owner; and

wherein, upon insertion of the ATM card into an ATM machine, the ATM machine reads both language identifiers from the ATM card and displays a user interface to the ATM card owner in the secondary preferred language identified by the secondary language identifier in the event that the primary preferred language is unavailable.

18. The ATM card as recited in claim 17, wherein the memory means further comprises a magnetic strip.

19. The ATM card as recited in claim 17, wherein the memory means further comprises an integrated circuit.

20. One or more computer-readable media containing computer-executable instructions that, when executed on a computer, perform the following steps:

reading a first language identifier and a second language identifier from a portable memory medium;

identifying a first preferred language associated with the first language identifier;
identifying a second preferred language associated with the second language identifier; and
displaying a user interface in the second preferred language in the event that a user interface in the first preferred language is unavailable.

21. The one or more computer-readable media as recited in claim 20, wherein the portable memory medium is an automated teller machine (ATM) card having a magnetic strip.

22. The one or more computer-readable media as recited in claim 20, wherein the portable memory medium is an integrated circuit (IC) card.

23. The one or more computer-readable media as recited in claim 20, further comprising computer-executable instructions that, when executed on a computer, perform the following additional step:

displaying the user interface in a default language in the event that the user interface cannot be displayed in the second preferred language.

25. An automated teller machine (ATM), comprising:

memory;

a processor;

a display;

a user interface produced by a user interface program stored in the memory and executable by the processor, the user interface being displayable on the display in more than one language;

a card reader configured to read data stored on memory means on an ATM card, the data including a primary language identifier that identifies a primary preferred language of an owner of the ATM card and a secondary language identifier that identifies a secondary preferred language of the owner of the ATM card; and

a language identification module stored in the memory and executable on the processor, the language identification module configured to select an appropriate language in which the user interface is displayed, said selection being based on the

availability of the primary preferred language identified by the primary language identifier and the secondary preferred language identified by the secondary language identifier.